



PATENT
Customer No. 22,852
Attorney Docket No. 5725.0595-00

AF
EPW

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)
)
Carlos PINZON et al.) Group Art Unit: 1615
)
Application No.: 09/733,900) Examiner: J. VENKAT
)
Filed: December 12, 2000) Confirmation No.: 5474
)
For: COSMETIC COMPOSITIONS)
CONTAINING AT LEAST ONE)
HETEROPOLYMER AND OIL)
SOLUBLE CATIONIC)
SURFACTANTS AND METHODS)
OF USING SAME)

Mail Stop Appeal Brief--Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

SUPPLEMENTAL APPEAL BRIEF UNDER 37 C.F.R. § 41.37

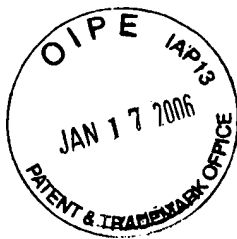
In response to the January 4, 2006, Notice of Non-Compliance With the Requirements of 37 C.F.R. § 41.37(c) directed to Applicants' December 1, 2005, Appeal Brief and in support of the Notice of Appeal filed September 2, 2005, pursuant to 37 C.F.R. § 41.37, Appellants present this Supplemental Appeal Brief.

This appeal is in response to the final Office Action dated June 2, 2005, rejecting claims 321-322, 325, 330, 334-335, 337-338, and 348-354 and objecting to claims 355-368, all of which are set forth in the attached Appendix.



Table of Contents

	Page
I. Real Party In Interest	1
II. Related Appeals and Interferences	2
III. Status Of Claims	3
IV. Status Of Amendments	4
V. Summary Of Claimed Subject Matter	5
VI. Grounds of Rejection to be Reviewed	9
VII. Argument	10
A. The Burden of Establishing a <i>Prima Facie</i> Case of Obviousness Falls On the Examiner	10
B. The Examiner Has Not Established That the References Provide the Requisite Motivation, Suggestion, or Teaching of the Desirability of Making the Specific Combination of the Present Invention	11
1. The Examiner does not offer sufficient motivation to combine the references	12
a. Pavlin	13
b. Murphy	14
c. Seidel	16
2. The teaching of the individual components in the individual references is not enough to defeat the patentability of the claimed invention	17
C. Conclusion	19
VIII. Claims Appendix	i
IX. Evidence Appendix	xiii
X. Related Proceedings Appendix	xiv



Application No. 09/733,900
Attorney Docket No. 5725.0595-00

I. **Real Party In Interest**

L'Oréal S.A. is the assignee of record as evidenced by the assignment recorded April 20, 2001, at reel 011639, frame 0897, and as such, L'Oréal S.A. is the real party in interest in this appeal.

II. Related Appeals and Interferences

Appellants bring to the attention of the Board the existence of a pending litigation. L'Oreal's U.S. Patent Nos. 6,716,420 B2 and 6,869,594, which are commonly assigned to the owner of the present application and claim related subject matter, are the subject of a patent infringement action filed by L'Oreal S.A. and L'Oreal USA, Inc. against Estee Lauder Companies, Inc., Estee Lauder, Inc., and Origins Natural Resources, Inc. in the United States District Court for the District of New Jersey. *L'Oreal S.A., et al. v. Estee Lauder Companies Inc., et al.*, Civil Action No. 04-1660 (HAA) (D.N.J. filed Apr. 7, 2004). This litigation was brought to the attention of the Examiner in the Notification of Pending Litigation filed July 23, 2004.

Additionally, Appellants bring to the attention of the Board the existence of an appeal in related copending Application No. 09/733,899 (Attorney Docket No. 5725.0594-00), directed to compositions comprising polymers of formula (I), as in the present application, and film-forming silicone resins. This co-pending application was previously brought to the attention of the Examiner in this application. The Notice of Appeal in Application No. 09/733,899 was filed on September 2, 2005. Although Application No. 09/733,899 is not directly related to the present application, Applicants bring this application and its appealed status to the Board's attention in the interest of full disclosure.

Appellants, Appellants' undersigned legal representative, and the assignee know of no other appeals, interferences, or proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status Of Claims

Claims 321-322, 325, 330, 334-335, 337-338, and 348-368 are pending. The Examiner has rejected claims 321-322, 325, 330, 334-335, 337-338, and 348-354¹ under 35 U.S.C. § 103(a). The Examiner has objected to claims 355-368 as being dependent upon a rejected base claim, but allowable if rewritten in independent form. As argued below, Appellants believe that the rejected claims are patentable.

¹ Appellants note that on page 2 of the Office Action, the Examiner states that claim 355 is rejected. Appellants believe this is an error due to the change in numbering noted by the Examiner on page 2 of the December 1, 2004, Office Action. Appellants have treated claim 355 herein as objected to in accordance with the listing in the "Disposition of Claims" on page 1 of the outstanding Office Action.

Appellants also note that the Examiner included claim 30 and omitted claim 330 from the listings in the "Disposition of Claims" on page 1 of the outstanding Office Action. Appellants believe this is a typographical error and the Examiner meant to include claim 330 rather than 30, and thus, have treated claim 330 herein as rejected in accordance with the Examiner's statement on page 2 of the outstanding Office Action.

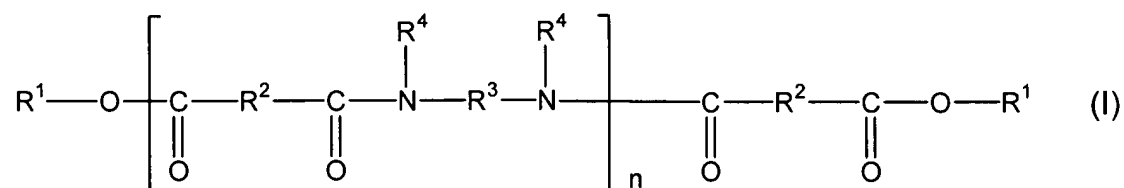
IV. Status Of Amendments

All amendments have been entered, and no amendments have been made subsequent to the issuance of the rejection dated June 2, 2005.

V. Summary Of Claimed Subject Matter

The use of high molecular weight polyamides to produce clear stick compositions has been known in the art since the mid-1960s. See Specification at p. 1. However, these compositions had significant drawbacks, such as tackiness, difficulty in application, and syneresis during storage. See *id.* Attempts to resolve these technical problems were only partially successful, improving application characteristics but not stability properties. See *id.* In the present case, Appellants have found that use of specific structuring polymers and oil-soluble cationic surfactants may result in a stable composition while maintaining desirable cosmetic application properties. See *id.* at pp. 1-2.

The presently claimed invention relates to a mascara, an eyeliner, a foundation, a lipstick, a blusher, a make-up-removing product, a make-up product for the body, an eyeshadow, a face powder, a concealer product, a nail composition, a shampoo, a conditioner, an anti-sun product or a care product for the skin, lips, or hair comprising a composition comprising at least one liquid fatty phase in said mascara, eyeliner, foundation, blusher, lipstick, make-up-removing product, make-up product for the body, eyeshadow, face powder, concealer product, nail composition, shampoo, conditioner, antisun product or care product for the skin, lips, or hair which comprises (i) at least one structuring polymer chosen from polyamide polymers of formula (I):



and (ii) at least one oil-soluble cationic surfactant. The claimed invention also relates to a make-up and/or care and/or treatment composition for keratinous fibers comprising at least one liquid fatty phase in said composition which comprises elements (i) and (ii) identified above.

The claimed invention also relates to a method of care, make up, or treatment of a keratin material chosen from lips, skin, and keratinous fibers comprising applying to said keratin material of a cosmetic composition comprising at least one liquid fatty phase in said composition which comprises elements (i) and (ii) identified above. The claimed invention also relates to a method of making a cosmetic composition in the form of a physiologically acceptable composition comprising including in said composition at least one liquid fatty phase in said composition which comprises elements (i) and (ii) identified above.

The claimed invention further relates to a method for providing at least one of resistance to shear and stability to a cosmetic composition, comprising including in said composition at least one liquid fatty phase which comprises elements (i) and (ii) identified above and wherein elements (i) and (ii) are present in a combined amount effective to provide at least one property chosen from resistance to shear and stability.

The claimed invention further relates to a treatment, care, or make-up composition for keratinous fibers comprising a structured composition containing: (i) at least one liquid fatty phase structured with at least one structuring polymer chosen from polyamide polymers of formula (I) and (ii) at least one oil-soluble cationic surfactant. The invention also relates to such a treatment, care, or make-up composition for keratinous fibers also comprising at least one coloring agent.

Support for the claimed invention can be found in the specification and claims as originally filed as set forth in Table 1 below.

Element	Support in Specification
A mascara, an eyeliner, a foundation, a lipstick, a blusher, a make-up-removing product, a make-up product for the body, an eyeshadow, a face powder, a concealer product, a nail composition, a shampoo, a conditioner, an anti-sun product or a care product for the skin, lips, or hair comprising a composition comprising: at least one liquid fatty phase in said mascara, eyeliner, foundation, blusher, lipstick, make-up-removing product, make-up product for the body, eyeshadow, face powder, concealer product, nail composition, shampoo, conditioner, antisun product or care product for the skin, lips, or hair	See original claim 321.
A make-up and/or care and/or treatment composition for keratinous fibers	See original claim 325.
A treatment, care or make-up composition for keratinous fibers comprising a structured composition	See original claim 330.
A method for care, make up, or treatment of a keratin material chosen from lips, skin, and keratinous fibers comprising applying to said keratin material of a cosmetic composition	See original claim 334.
A method for making a cosmetic composition in the form of a physiologically acceptable composition comprising including in said composition	See original claim 335.
A method for providing at least one of resistance to shear and stability to a cosmetic composition, comprising including in said cosmetic composition a cosmetic composition	See original claim 337.
A make up, care, or treatment composition for the skin or lips comprising a structured composition	See original claim 338.
(i) at least one structuring polymer chosen from polyamide polymers of formula (I):	See specification at p. 10, ln. 3 to p. 11, ln. 4.

$R^1-O-\left[\begin{array}{c} \text{C} \\ \parallel \\ \text{O} \end{array} -R^2-\begin{array}{c} \text{C} \\ \parallel \\ \text{O} \end{array}-\overset{\overset{R^4}{ }}{\text{N}}-R^3-\overset{\overset{R^4}{ }}{\text{N}} \right]_n-\begin{array}{c} \text{C} \\ \parallel \\ \text{O} \end{array}$	
<p>in which:</p> <ul style="list-style-type: none"> - n is an integer which represents the number of amide units such that the number of ester groups present in said at least one structuring polymer ranges from 10% to 50% of the total number of all said ester groups and all said amide groups comprised in said at least one structuring polymer; - R¹, which are identical or different, are each chosen from alkyl groups having at least 4 carbon atoms and alkenyl groups having at least 4 carbon atoms; - R², which are identical or different, are each chosen from C₄ to C₄₂ hydrocarbon-based groups with the proviso that at least 50% of R² are chosen from C₃₀ to C₄₂ hydrocarbon-based groups; - R³, which are identical or different, are each chosen from C₂ to C₃₆ hydrocarbon-based groups; and - R⁴, which are identical or different, are each chosen from hydrogen and C₁ to C₁₀ alkyl groups, with the proviso that at least 50% of all R⁴ are chosen from hydrogen 	
(ii) at least one oil-soluble cationic surfactant	See original claim 321; see also specification at p. 25, ln. 16 to p. 29, ln. 26.
at least one coloring agent	See original claim 330.
and further wherein said at least one structuring polymer and said at least one oil-soluble cationic surfactant are present in a combined amount effective to provide at least one property chosen from resistance to shear and stability.	See original claim 337.

VI. Grounds of Rejection to be Reviewed

Claims 321-322, 325, 330, 334-335, 337-338, and 348-354 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,783,657 to Pavlin et al. ("Pavlin") in view of U.S. Patent No. 6,423,324 to Murphy et al. ("Murphy") and U.S. Patent No. 5,830,483 to Seidel et al. ("Seidel").

VII. Argument

**Claims 321-322, 325, 330, 334-335, 337-338, and 348-354
Are Patentable Under 35 U.S.C. § 103(a) Over Pavlin in
View of Murphy and Seidel**

Claims 321-322, 325, 330, 334-335, 337-338, and 348-354 are patentable under 35 U.S.C. § 103(a) over Pavlin in view of Murphy and Seidel. Appellants submit that the Examiner has not established a *prima facie* case of obviousness because there would have been no motivation for one of ordinary skill in the art to combine the teachings of the references.

Instead, as discussed below, to support the alleged motivation to combine, the Examiner has merely found individual references that may separately teach components of the claimed invention, but that fail to motivate one to use all of the claimed components together.

**A. The Burden of Establishing a *Prima Facie* Case
of Obviousness Falls On the Examiner**

In making a rejection under 35 U.S.C. § 103, the Examiner has the initial burden to establish a *prima facie* case of obviousness. M.P.E.P. § 2143. To meet this burden, the Examiner must point to some objective teaching in the prior art, coupled with the knowledge generally available to one of ordinary skill in the art at the time of the invention, that would have motivated one of ordinary skill to combine reference teachings with a reasonable expectation of success in obtaining the presently claimed invention. See M.P.E.P. §§ 2143.01 and 2143.02; *In re Fine*, 5 U.S.P.Q.2d 1596, 1598, 837 F.2d 1071, 1074 (Fed. Cir. 1988). The Federal Circuit has stated that:

[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record Thus the Board must not only assure that the requisite

findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

In re Lee, 61 U.S.P.Q.2d 1430, 1434, 277 F.3d 1338, 1344 (Fed. Cir. 2002) (emphasis added).

Both the suggestion and the reasonable expectation of success must be found in the prior art references, not in the Appellants' disclosure. See *In re Vaeck*, 20 U.S.P.Q.2d 1438, 947 F.2d 488 (Fed. Cir. 1991).

B. The Examiner Has Not Established That the References Provide the Requisite Motivation, Suggestion, or Teaching of the Desirability of Making the Specific Combination of the Present Invention

The threshold for establishing a motivation to combine is high, requiring "clear and particular" evidence of a motivation to combine. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617, 175 F.3d 994, 999 (Fed. Cir. 1999). As explained by the Federal Circuit, "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *Id.*, at 1617, 175 F.3d at 999. Therefore, this evidence must be explicitly set forth by the Examiner. See *In re Lee*, 61 U.S.P.Q.2d at 1433, 277 F.3d at 1343.

In the present case, the Examiner asserts that motivation to make the proposed combination of at least one oil-soluble cationic surfactant with the polyamide polymer of Pavlin flows from the expectation that the resulting composition would exhibit "outstanding properties." See June 2, 2005, Office Action at p. 4. The Examiner concludes, therefore, that the present claims are obvious. See *id.* Appellants disagree.

1. The Examiner does not offer sufficient motivation to combine the references

The Examiner improperly bases her conclusion on the assertion that the references contain various elements of the present claims. As described above, the present invention is, for example, a mascara, an eyeliner, a foundation, a lipstick, a blusher, a make-up-removing product, a make-up product for the body, an eyeshadow, a face powder, a concealer product, a nail composition, a shampoo, a conditioner, an anti-sun product or a care product for the skin, lips, or hair comprising a composition comprising at least one liquid fatty phase in said mascara, eyeliner, foundation, blusher, lipstick, make-up-removing product, make-up product for the body, eyeshadow, face powder, concealer product, nail composition, shampoo, conditioner, antisun product or care product for the skin, lips, or hair which comprises (i) at least one structuring polymer chosen from polyamide polymers of formula (I) and (ii) at least one oil-soluble cationic surfactant. See, *e.g.*, claim 321. The Examiner asserts that Pavlin teaches the claimed polyamide polymers as gelling agents and “the application of this gellant in various cosmetic personal care products.” June 2, 2005, Office Action at p. 2. The Examiner relies on Murphy as teaching the combination of a polyamide resin and a cationic surfactant, and points to Seidel as teaching particular oil-soluble cationic surfactants in combination with non-ionic surfactants resulting in “outstanding properties.” See December 1, 2004, Office Action at pp. 4-5. From this, the Examiner concludes that one of ordinary skill in the art would have been “motivated to combine the structuring polymer and substitute the oil soluble cationic surfactant of [Seidel] for the cationic surfactant in the compositions of [Murphy] with a reasonable expectation of

success that the compositions would exhibit outstanding properties.” See June 2, 2005, Office Action at p. 4.

The Examiner, however, fails to point to any evidence of record that any of the references provide the requisite motivation, suggestion, or teaching of the desirability of making the proposed combination by extracting the elements disclosed in Seidel and Murphy and using them in the compositions of Pavlin. Instead, the Examiner has merely provided a conclusory statement that such motivation exists, stating that the motivation to make the proposed combination “flows logically from the art for having been used in the same cosmetic art.” *Id.* at p. 4. Moreover, there simply is no “clear and particular” motivation to make the proposed combination in the cited art.

a. Pavlin

Pavlin relates to methods for preparing gelling agents that can be used in formulating transparent gels. See *e.g.*, Pavlin at col. 1, Ins. 5-8, col. 2, Ins. 17-21, claim 1. The gels of Pavlin are disclosed as being useful in a variety of compositions, including, for example, automobile wax/polish, furniture polish, metal cleaners/polishes, household cleaners, paint strippers, insecticides, fuels, toilet bowl rings, crayons, etc., in addition to cosmetics. See, *e.g.*, *id.* at col. 14, Ins. 37-53. The only exemplified formulation embodying the invention of Pavlin is in the form of a candle. See *id.* at Example 25. Pavlin does not contain any teaching or suggestion whatsoever to formulate a cosmetic composition specifically containing at least one oil-soluble cationic surfactant, and the Examiner conceded as much. See July 16, 2003, Office Action at p. 4.

Moreover, there is no teaching or suggestion in Pavlin that would have led the skilled artisan to add an oil-soluble cationic surfactant to the compositions therein to produce a cosmetic composition with “outstanding properties,” as the Examiner alleges. Pavlin teaches that its compositions do not exhibit syneresis, as the Examiner points out. See July 16, 2004, Office Action at p. 4. Nevertheless, the Examiner asserts that the motivation for the proposed combination of Pavlin with Murphy and Seidel is to achieve “outstanding properties” (*i.e.*, to improve the stability and appearance of the compositions by reducing susceptibility of the composition to syneresis). See July 16, 2003 Office Action at p. 5. However, it is illogical to assert that one of skill in the art would have been motivated to add an oil-soluble cationic surfactant to Pavlin with the expectation of reducing syneresis because Pavlin’s compositions are already free of this drawback. One of skill in the art simply would not have been motivated to remedy a problem that the reference itself affirmatively states does not exist in its compositions.

b. Murphy

The Examiner has not provided, and Murphy does not contain, any teaching that would have suggested specifically selecting cationic surfactants, let alone oil-soluble cationic surfactants, from the list of optional ingredients in Murphy for combination with the gel formulations of Pavlin. First, Murphy does not specifically mention oil-soluble cationic surfactants anywhere, but instead merely incorporates by reference a laundry list of more than 340 cationic surfactants, none of which are identified as to whether they are oil-soluble or water-soluble. See McCutcheon’s at pp. 272-73.

Moreover, while Appellants do not assert that Murphy fails to teach or suggest at least one cationic surfactant at all, one of ordinary skill in the art would not have been

motivated to add such a cationic surfactant to the composition of Pavlin, in light of both the brief disclosure and the non-preferred nature of the cationic surfactant. While Murphy does teach the use of surfactants, it states that the surfactant is optional. See col. 8, ln. 66 to col. 9, ln. 2. Furthermore, the reference specifically states that, when optionally included, non-ionic surfactants are preferred. See *id.* at col. 9, lns. 8-10. Murphy provides over a column and a half of detailed text regarding the preferred non-ionic surfactants, col. 9, ln. 8 to col. 10, ln. 45, yet only summarily adds that cationic surfactants “can be used as the surfactant,” col. 10, lns. 46-47. In view of this disclosure, even assuming *arguendo* that one of ordinary skill in the art would have been motivated to add the optional surfactant of Murphy to the composition of Pavlin, he would have chosen a non-ionic surfactant, the preferred surfactant in Murphy. It is even more unreasonable to conclude that one of ordinary skill in the art would have been motivated to pick and choose specifically an oil-soluble cationic surfactant, incorporated by reference and buried amongst a disclosure of hundreds of other cationic surfactants.

Rather, one of ordinary skill in the art, when reading this disclosure as a whole, would select a nonionic surfactant based on the detailed and specific teachings and would not pick a cationic surfactant that happens to be oil-soluble instead. To conclude otherwise is a failure read the disclosure as a whole, in favor of improperly picking and choosing from the disclosure. “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). Such picking and choosing is improper.

Furthermore, as explained above, both Pavlin and Murphy disclose that the compositions exhibit reduced or no syneresis; therefore, it is illogical to suggest that motivation for their combination lies in the desire to make the disclosed compositions resistant to syneresis. In fact, Murphy actually teaches away from this alleged motivation. At column 7, lines 1-20, Murphy discusses how the combination of the polyamide with the solvent actually shows increased syneresis in the absence of the specific, required gelling agent. Thus, one of skill in the art would not have been motivated to randomly pick and choose elements from the disclosure in Murphy in order to reduce syneresis in the composition of Pavlin, without also adding the specifically disclosed gelling agent, in light of this teaching. Murphy does not attribute the stability of the composition to the combination of a polyamide resin and blend of surfactants as the Examiner implies. See July 16, 2003, Office Action at p. 4.

Accordingly, the Examiner has failed to establish that one of ordinary skill would have been motivated to combine the cationic surfactant of Murphy with the composition of Pavlin, and further that the cationic surfactant would have been an oil-soluble cationic surfactant.

c. Seidel

Finally, Seidel does not provide motivation for the combination of the cited references. The Examiner has not provided, and Seidel does not contain, any teaching that would have suggested specifically selecting lauryl methyl gluceth-10 hydroxypropyl ammonium chloride from the list of ionic emulsifiers disclosed therein for combination with the gel formulations of Pavlin. The Examiner asserts that one of skill in the art would have been motivated to make the proposed combination based on the desire to

obtain a composition with “outstanding properties,” such as modifying viscosity and achieving a rich appearance as disclosed in Seidel. See June 2, 2005, Office Action at p. 4. Appellants disagree.

Appellants point out that Seidel attributes these properties to the inventive oil-in-water emulsion disclosed therein which contains an emulsifying system which contains both a nonionic and an ionic emulsifier, see col. 4, Ins. 45-52, and not specifically to the presence of an oil-soluble cationic surfactant as the Examiner implies, see July 16, 2003, Office Action at p. 5. Further, there is nothing in any of the references of record to suggest that these properties relied on by the Examiner would be retained in a composition that was not an emulsion, such as the compositions of Pavlin and Murphy. Moreover, there is nothing in any of the references to suggest that these properties would be retained if one of skill in the art nevertheless chose to add one component of the emulsion system to a composition that is not an emulsion, as suggested by the Examiner. Finally, there is no suggestion in Pavlin, Murphy, or Seidel of the need or desire to obtain a composition with these properties such that one of skill in the art would have been motivated to select the particular component selected by the Examiner for combination with those compositions, even if it was attributed with producing such properties.

2. The teaching of the individual components in the individual references is not enough to defeat the patentability of the claimed invention

Even though the individual components of the presently claimed invention may be found separately in the references of record, these separate disclosures do not defeat the patentability of the composition as a whole. Merely identifying each of the

claimed elements in the prior art, as the Examiner has done here, is not sufficient to establish a *prima facie* case of obviousness. The Federal Circuit has held that “[m]ost if not all inventions arise from a combination of old elements However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (citations omitted). It is not sufficient to merely “find every element of a claimed invention in the prior art” and for the Examiner to “use the claimed invention itself as a blue print for piecing together elements Such an approach would be an illogical and inappropriate process by which to determine patentability.” *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (citations and quotations omitted).

Rather, when a claimed invention combines two known elements, a patentability determination rests on “whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.” *In re Beattie*, 24 U.S.P.Q.2d 1040, 1042, 974 F.2d 1309, 1311 (Fed. Cir. 1992) (citations omitted). More specifically, “[w]hen an obviousness determination is based on multiple prior art references, there must be a showing of some ‘teaching, suggestion, or reason’ to combine the references.” *Winner Int’l Royalty Corp. v. Wang*, 53 U.S.P.Q.2d 1580, 1586, 202 F.3d 1340, 1348 (Fed. Cir. 2000), citing *Gambro Lundia AB v. Baxter Healthcare Corp.*, 42 U.S.P.Q.2d 1378, 1383, 110 F.3d 1573, 1579 (Fed. Cir. 1997). This has not been done in the present case.

When the “rigorous” standards of the prevailing law are applied in this case, it becomes apparent that the combination of elements from these three references is

improper. There is no specific suggestion of the desirability of the combination here, as discussed above. The Examiner has merely found references that may separately teach components of the claimed invention but that fail to motivate one to use all of the claimed components together. The Examiner has not pointed to any teaching in the references or in the knowledge of those skilled in the art particularly suggesting the desirability of their combination. Rather, the Examiner improperly uses the present invention as a "blue print" for piecing together elements from the three references. It is illogical to suggest that one of skill in the art would pick a particular oil-soluble cationic surfactant from Seidel for use in the compositions of Pavlin based on the teaching of an entirely separate reference, Murphy, which describes those surfactants as optional ingredients in the disclosed compositions. This is particularly true in view of the specific disclosures of each reference as detailed above.

Accordingly, these three references could not have provided any motivation for one of ordinary skill in the art to reach the presently claimed invention, and Appellants submit that the rejection is improper and should be reversed.

C. Conclusion


Accordingly, for the reasons set forth above, Appellants maintain that a *prima facie* case of obviousness has not been established based on the cited references. The Examiner has failed to demonstrate that one of ordinary skill in the art would have been motivated to make the proposed combination. Thus, Appellants respectfully request reversal of the rejection of claims 321-322, 325, 330, 334-335, 337-338, and 348-354 under 35 U.S.C. § 103(a).

To the extent any extension of time under 37 C.F.R. § 1.136 not requested herewith is required to obtain entry of this Supplemental Appeal Brief, such extension is hereby respectfully requested. If there are any fees due which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 17, 2006

By: 
Michelle E. O'Brien
Reg. No. 46,203

Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, D.C. 20005
(202) 408-4000

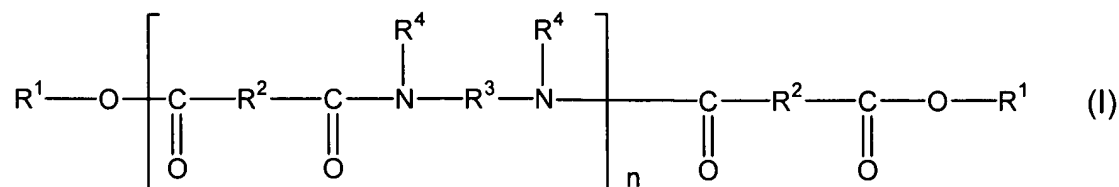


VIII. Claims Appendix

1. - 320. (Canceled)

321. (Previously presented) A mascara, an eyeliner, a foundation, a lipstick, a blusher, a make-up-removing product, a make-up product for the body, an eyeshadow, a face powder, a concealer product, a nail composition, a shampoo, a conditioner, an anti-sun product or a care product for the skin, lips, or hair comprising a composition comprising at least one liquid fatty phase in said mascara, eyeliner, foundation, blusher, lipstick, make-up-removing product, make-up product for the body, eyeshadow, face powder, concealer product, nail composition, shampoo, conditioner, antisun product or care product for the skin, lips, or hair which comprises:

(i) at least one structuring polymer chosen from polyamide polymers of formula (I):



in which:

- n is an integer which represents the number of amide units such that the number of ester groups present in said at least one structuring polymer ranges from 10% to 50% of the total number of all said ester groups and all said amide groups comprised in said at least one structuring polymer;

- R¹, which are identical or different, are each chosen from alkyl groups having at least 4 carbon atoms and alkenyl groups having at least 4 carbon atoms;

- R^2 , which are identical or different, are each chosen from C_4 to C_{42}

hydrocarbon-based groups with the proviso that at least 50% of R^2 are chosen from C_{30} to C_{42} hydrocarbon-based groups;

- R^3 , which are identical or different, are each chosen from C_2 to C_{36}

hydrocarbon-based groups; and

- R^4 , which are identical or different, are each chosen from hydrogen and C_1 to C_{10} alkyl groups, with the proviso that at least 50% of all R^4 are chosen from hydrogen; and

(ii) at least one oil-soluble cationic surfactant.

322. (Original) The composition according to claim 321, wherein said composition is a solid.

323. (Canceled)

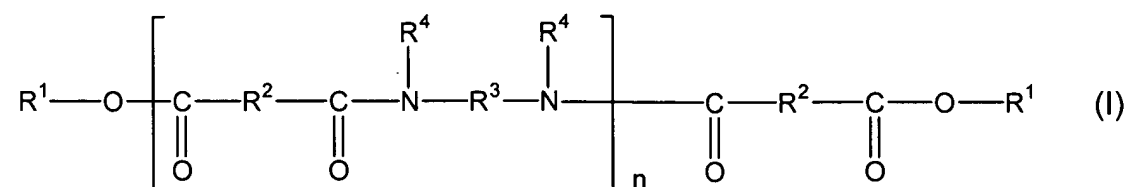
324. (Canceled)

325. (Previously presented) A make-up and/or care and/or treatment composition for keratinous fibers comprising:

at least one liquid fatty phase in said composition which comprises:

(i) at least one structuring polymer chosen from polyamide polymers of formula

(I):



in which:

- n is an integer which represents the number of amide units such that the number of ester groups present in said at least one structuring polymer ranges from 10% to 50% of the total number of all said ester groups and all said amide groups comprised in said at least one structuring polymer;

- R¹, which are identical or different, are each chosen from alkyl groups having at least 4 carbon atoms and alkenyl groups having at least 4 carbon atoms;

- R², which are identical or different, are each chosen from C₄ to C₄₂ hydrocarbon-based groups with the proviso that at least 50% of R² are chosen from C₃₀ to C₄₂ hydrocarbon-based groups;

- R³, which are identical or different, are each chosen from C₂ to C₃₆ hydrocarbon-based groups; and

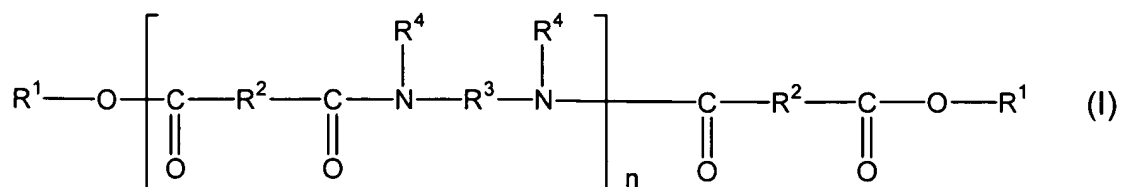
- R⁴, which are identical or different, are each chosen from hydrogen and C₁ to C₁₀ alkyl groups, with the proviso that at least 50% of all R⁴ are chosen from hydrogen; and

(ii) at least one oil-soluble cationic surfactant.

326. - 329. (Canceled)

330. (Previously presented) A treatment, care or make-up composition for keratinous fibers comprising a structured composition containing

(i) at least one liquid fatty phase structured with at least one structuring polymer chosen from polyamide polymers of formula (I):



in which:

- n is an integer which represents the number of amide units such that the number of ester groups present in said at least one structuring polymer ranges from 10% to 50% of the total number of all said ester groups and all said amide groups comprised in said at least one structuring polymer;

- R^1 , which are identical or different, are each chosen from alkyl groups having at least 4 carbon atoms and alkenyl groups having at least 4 carbon atoms;

- R^2 , which are identical or different, are each chosen from C_4 to C_{42} hydrocarbon-based groups with the proviso that at least 50% of R^2 are chosen from C_{30} to C_{42} hydrocarbon-based groups;

- R^3 , which are identical or different, are each chosen from C_2 to C_{36} hydrocarbon-based groups; and

- R^4 , which are identical or different, are each chosen from hydrogen and C_1 to C_{10} alkyl groups, with the proviso that at least 50% of all R^4 are chosen from hydrogen,

(ii) at least one oil-soluble cationic surfactant, and

(iii) at least one coloring agent.

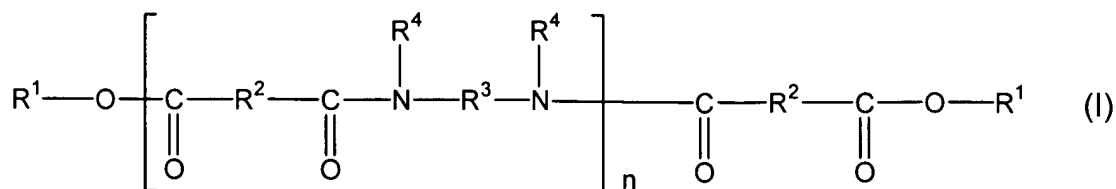
331. - 333. (Canceled)

334. (Previously presented) A method for care, make up, or treatment of a keratin material chosen from lips, skin, and keratinous fibers, comprising applying to said keratin material of a cosmetic composition comprising:

at least one liquid fatty phase which comprises:

(i) at least one structuring polymer chosen from polyamide polymers of formula

(I):



in which:

- n is an integer which represents the number of amide units such that the number of ester groups present in said at least one structuring polymer ranges from 10% to 50% of the total number of all said ester groups and all said amide groups comprised in said at least one structuring polymer;

- R¹, which are identical or different, are each chosen from alkyl groups having at least 4 carbon atoms and alkenyl groups having at least 4 carbon atoms;

- R², which are identical or different, are each chosen from C₄ to C₄₂ hydrocarbon-based groups with the proviso that at least 50% of R² are chosen from C₃₀ to C₄₂ hydrocarbon-based groups;

- R³, which are identical or different, are each chosen from C₂ to C₃₆ hydrocarbon-based groups; and

- R⁴, which are identical or different, are each chosen from hydrogen and C₁ to C₁₀ alkyl groups, with the proviso that at least 50% of all R⁴ are chosen from hydrogen; and

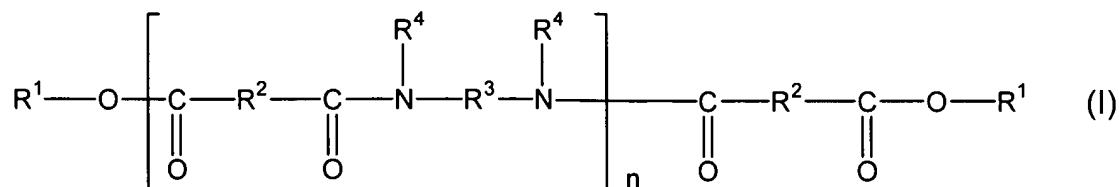
(ii) at least one oil-soluble cationic surfactant.

335. (Previously presented) A method for making a cosmetic composition in the form of a physiologically acceptable composition comprising including in said composition

at least one liquid fatty phase which comprises:

(i) at least one structuring polymer chosen from polyamide polymers of formula

(I):



in which:

- n is an integer which represents the number of amide units such that the number of ester groups present in said at least one structuring polymer ranges from 10% to 50% of the total number of all said ester groups and all said amide groups comprised in said at least one structuring polymer;

- R¹, which are identical or different, are each chosen from alkyl groups having at least 4 carbon atoms and alkenyl groups having at least 4 carbon atoms;

- R², which are identical or different, are each chosen from C₄ to C₄₂ hydrocarbon-based groups with the proviso that at least 50% of R² are chosen from C₃₀ to C₄₂ hydrocarbon-based groups;

- R³, which are identical or different, are each chosen from C₂ to C₃₆ hydrocarbon-based groups; and

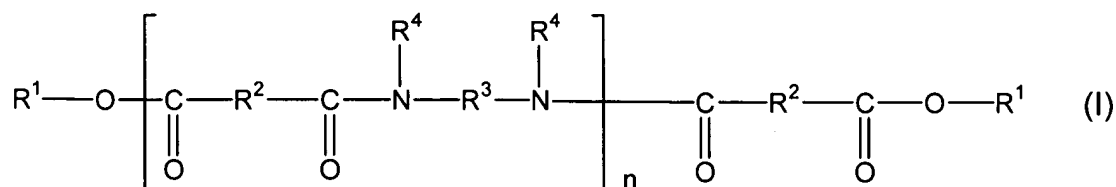
- R⁴, which are identical or different, are each chosen from hydrogen and C₁ to C₁₀ alkyl groups, with the proviso that at least 50% of all R⁴ are chosen from hydrogen; and

(ii) at least one oil-soluble cationic surfactant.

336. (Canceled)

337. (Original) A method for providing at least one of resistance to shear and stability to a cosmetic composition, comprising including in said cosmetic composition a cosmetic composition at least one liquid fatty phase which comprises:

(i) at least one structuring polymer chosen from polyamide polymers of formula (I):



in which:

- n is an integer which represents the number of amide units such that the number of ester groups present in said at least one structuring polymer ranges from 10% to 50% of the total number of all said ester groups and all said amide groups comprised in said at least one structuring polymer;

- R¹, which are identical or different, are each chosen from alkyl groups having at least 4 carbon atoms and alkenyl groups having at least 4 carbon atoms;

- R², which are identical or different, are each chosen from C₄ to C₄₂ hydrocarbon-based groups with the proviso that at least 50% of R² are chosen from C₃₀ to C₄₂ hydrocarbon-based groups;

- R³, which are identical or different, are each chosen from C₂ to C₃₆ hydrocarbon-based groups; and

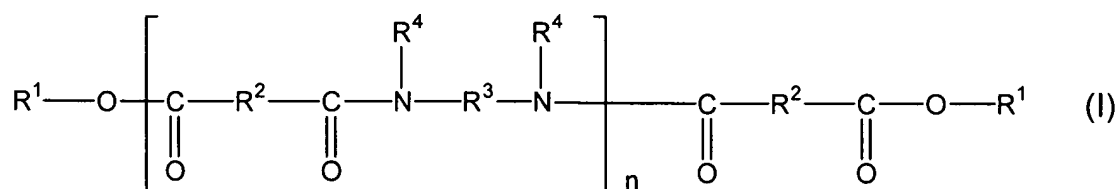
- R⁴, which are identical or different, are each chosen from hydrogen and C₁ to C₁₀ alkyl groups, with the proviso that at least 50% of all R⁴ are chosen from hydrogen; and

(ii) at least one oil-soluble cationic surfactant,

and further wherein said at least one structuring polymer and said at least one oil-soluble cationic surfactant are present in a combined amount effective to provide at least one property chosen from resistance to shear and stability.

338. (Previously presented) A make up, care, or treatment composition for the skin or lips comprising a structured composition comprising

(i) at least one liquid fatty phase in said make up, care, or treatment composition structured with at least one structuring polymer chosen from polyamide polymers of formula (I):



in which:

- n is an integer which represents the number of amide units such that the number of ester groups present in said at least one structuring polymer ranges from 10% to 50% of the total number of all said ester groups and all said amide groups comprised in said at least one structuring polymer;

- R¹, which are identical or different, are each chosen from alkyl groups having at least 4 carbon atoms and alkenyl groups having at least 4 carbon atoms;

- R², which are identical or different, are each chosen from C₄ to C₄₂ hydrocarbon-based groups with the proviso that at least 50% of R² are chosen from C₃₀ to C₄₂ hydrocarbon-based groups;

- R³, which are identical or different, are each chosen from C₂ to C₃₆

hydrocarbon-based groups; and

- R⁴, which are identical or different, are each chosen from hydrogen and C₁ to C₁₀ alkyl groups, with the proviso that at least 50% of all R⁴ are chosen from hydrogen, and

(ii) at least one oil-soluble cationic surfactant.

339. - 347. (Canceled)

348. (Previously presented) The mascara, eyeliner, foundation, lipstick, blusher, make-up-removing product, make-up product for the body, eyeshadow, face powder, concealer product, nail composition, shampoo, conditioner, anti-sun product or care product for the skin, lips, or hair according to claim 321, wherein the at least one oil-soluble cationic surfactant is lauryl methyl gluceth-10-hydroxypropyl dimmonium chloride.

349. (Previously presented) The make-up and/or care and/or treatment composition according to claim 325, wherein the at least one oil-soluble cationic surfactant is lauryl methyl gluceth-10-hydroxypropyl dimmonium chloride.

350. (Previously presented) The treatment, care or make-up composition according to claim 330, wherein the at least one oil-soluble cationic surfactant is lauryl methyl gluceth-10-hydroxypropyl dimmonium chloride.

351. (Previously presented) The method for care, make up, or treatment according to claim 334, wherein the at least one oil-soluble cationic surfactant is lauryl methyl gluceth-10-hydroxypropyl dimmonium chloride.

352. (Previously presented) The method for making a cosmetic composition according to claim 335, wherein the at least one oil-soluble cationic surfactant is lauryl methyl gluceth-10-hydroxypropyl dimmonium chloride.

353. (Previously presented) The method for providing at least one of resistance to shear and stability to a cosmetic composition according to claim 337, wherein the at least one oil-soluble cationic surfactant is lauryl methyl gluceth-10-hydroxypropyl dimmonium chloride.

354. (Previously presented) The make up, care, or treatment composition according to claim 338, wherein the at least one oil-soluble cationic surfactant is lauryl methyl gluceth-10-hydroxypropyl dimmonium chloride.

355. (Previously presented) The mascara, eyeliner, foundation, lipstick, blusher, make-up-removing product, make-up product for the body, eyeshadow, face powder, concealer product, nail composition, shampoo, conditioner, anti-sun product or care product for the skin, lips, or hair according to claim 321, wherein the at least one structuring polymer is chosen from ethylenediamine/stearyl dimer tallate copolymer.

356. (Previously presented) The make-up and/or care and/or treatment composition according to claim 325, wherein the at least one structuring polymer is chosen from ethylenediamine/stearyl dimer tallate copolymer.

357. (Previously presented) The treatment, care or make-up composition according to claim 330, wherein the at least one structuring polymer is chosen from ethylenediamine/stearyl dimer tallate copolymer.

358. (Previously presented) The method for care, make up, or treatment according to claim 334, wherein the at least one structuring polymer is chosen from ethylenediamine/stearyl dimer tallate copolymer.

359. (Previously presented) The method for making a cosmetic composition according to claim 335, wherein the at least one structuring polymer is chosen from ethylenediamine/stearyl dimer tallate copolymer.

360. (Previously presented) The method for providing at least one of resistance to shear and stability to a cosmetic composition according to claim 337, wherein the at least one structuring polymer is chosen from ethylenediamine/stearyl dimer tallate copolymer.

361. (Previously presented) The make up, care, or treatment composition according to claim 338, wherein the at least one structuring polymer is chosen from ethylenediamine/stearyl dimer tallate copolymer.

362. (Previously presented) The mascara, an eyeliner, a foundation, a lipstick, a blusher, a make-up-removing product, a make-up product for the body, an eyeshadow, a face powder, a concealer product, a nail composition, a shampoo, a conditioner, an anti-sun product or a care product for the skin, lips, or hair according to claim 321, wherein the at least one structuring polymer is chosen from ethylenediamine/stearyl dimer dilinoleate copolymer.

363. (Previously presented) The make-up and/or care and/or treatment composition according to claim 325, wherein the at least one structuring polymer is chosen from ethylenediamine/stearyl dimer dilinoleate copolymer.

364. (Previously presented) The treatment, care or make-up composition according to claim 330, wherein the at least one structuring polymer is chosen from ethylenediamine/stearyl dimer dilinoleate copolymer.

365. (Previously presented) The method for care, make up, or treatment according to claim 334, wherein the at least one structuring polymer is chosen from ethylenediamine/stearyl dimer dilinoleate copolymer.

366. (Previously presented) The method for making a cosmetic composition according to claim 335, wherein the at least one structuring polymer is chosen from ethylenediamine/stearyl dimer dilinoleate copolymer.

367. (Previously presented) The method for providing at least one of resistance to shear and stability to a cosmetic composition according to claim 337, wherein the at least one structuring polymer is chosen from ethylenediamine/stearyl dimer dilinoleate copolymer.

368. (Previously presented) The make up, care, or treatment composition according to claim 338, wherein the at least one structuring polymer is chosen from ethylenediamine/stearyl dimer dilinoleate copolymer.

IX. Evidence Appendix

None.

X. **Related Proceedings Appendix**

None.